



**RESPONSE UNDER 37 CFR 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 2871**

Docket No.: 1185.1055

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Fuminori HIRAISHI

Serial No. 09/726,329

Group Art Unit: 2871

Confirmation No. 1030

Filed: December 01, 2000

Examiner: Dung T. Nguyen

For: LIGHT CRYSTAL DISPLAY, SURFACE LIGHT SOURCE DEVICE, AND LIQUID
CONTROL SHEET

REQUEST FOR RECONSIDERATION

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Attn: Box AF

Sir:

This is in response to the final Office Action mailed December 8, 2003, having a period for response set to expire on March 8, 2004. A Petition for a three-month extension of time, together with the requisite fee, is submitted herewith, making the period for response end on June 8, 2004. The Examiner's rejections are traversed below.

In the December 8, 2003 Office Action, the Examiner noted that claims 1-6 were pending in the application and rejected claims 1-6 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent 5,587,816 to Gunjima et al. (Reference A). In the first paragraph on page 3 of the Office Action, the Examiner indicated that the limitation "made through a resin material drawing process" (e.g., claim 1, line 9) was not given any patentable weight, because this limitation "recites a one-step process which does not further limit the structure" (page 3, lines 1-2), citing MPEP § 2113.

It is not clear what portion of MPEP § 2113 was being cited as support for ignoring the above-quoted limitation from claim 1. There are many statements in MPEP § 2113 that provide

reasons why all of the limitation **should be considered**. Although MPEP § 2113 is directed to product-by-process claims and claims 1-6 are not product-by-process claims, the quoted phrase on line 9 of claim 1 is the type of limitation found in a product-by-process claim and therefore it is believed that many of the statements in MPEP § 2113 apply. Specifically,

[t]he structure implied by the process ... should be considered when assessing the patentability ... over the prior art, especially ... where the manufacturing process ... would be expected to impart distinctive structural characteristics to the final product. See, e.g., *In re Garnero*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979)

(MPEP § 2113, 8th Ed., Rev. 1, second paragraph). On the other hand, nothing has been found in MPEP § 2113 suggesting that an apparatus claim cannot contain a single product-by-process limitation that is given patentable weight under the same rules that apply to a claim directed to a product reciting the process steps used to create that product, i.e., a "product-by-process claim." It is submitted that the holding of *In re Garnero* is consistent with requiring an anticipatory prior art reference to disclose a light control sheet that could be "made through a resin material drawing process ...[which provides] a polarization rotating ability that said light control sheet acquired during the resin material drawing process" (e.g., claim 1, last five lines).

At the bottom of page 2 of the Office Action it was asserted that the prism array 7 described at column 12, lines 31-45 and illustrated in Fig. 1 of Gunjima et al. met all of the limitations recited in the claims for the light control sheet. However, there is no form of the word "rotate" in the cited portion of column 12 in Gunjima et al. describing the prism array. Rather, "the rotation of the optical axis of polarization of light" (column 14, lines 36-37) is discussed from column 14, line 33 to column 15, line 20. The only other uses of words related to "rotation" after the brief description of the drawings in column 4 appear at column 17, line 65 and column 19, line 41 which respectively describe rotation by 90° and 85° in different embodiments. The "polarization rotating means" (column 14, lines 33-34) of Gunjima et al. is described as including "a flat sheet" (column 15, line 14), but the polarization rotating means is embodied by "media having the birefringence ... laminated in multi-layers" (column 14, lines 40-41) and thus, is not a single flat sheet. No further occurrences of "polarization rotating means" have been found outside the second half of column 14 and first quarter of column 15. In short, nothing has been found, nor was cited by the Examiner, suggesting that the prism array 7 disclosed by Gunjima et al. provides "a polarization rotating ability" (claim 1, lines 11-12) even if it is ignored that the claims require this ability to be "acquired during the resin material drawing process" (e.g., claim 1, last two lines).

Since limitations similar to those quoted above from claim 1 are recited in claims 2 and 3 and claims 4-6 depend from claims 1-3, it is submitted that claims 1-6 patentably distinguish over Gunjima et al. reconsideration of the claims and an early Notice of Allowance are earnestly solicited.

If there are any additional fees associated with the filing of this Response, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 6/8/04

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AF/2871
IFW

S&H Form: (10/03)

REPLY/AMENDMENT FEE TRANSMITTAL		Attorney Docket No.		1185.1055	
		Application Number		09/726,329	
		Filing Date		December 01, 2000	
		First Named Inventor		Fuminori HIRAISHI	
		Group Art Unit		2871	
AMOUNT ENCLOSED		1280.00		Examiner Name Dung T. Nguyen	
FEE CALCULATION (fees effective 10/01/03)					
CLAIMS AS AMENDED	Claims Remaining After Amendment	Highest Number Previously Paid For	Number Extra	Rate	Calculations
TOTAL CLAIMS	6	- 20 =	0	X \$ 18.00 =	\$ 0.00
INDEPENDENT CLAIMS	3	- 3 =	0	X \$ 86.00 =	0.00
Since an Official Action set an <u>original</u> due date of <u>March 8, 2004</u> , petition is hereby made for an extension to cover the date this reply is filed for which the requisite fee is enclosed (1 month (\$110); 2 months (\$420); 3 months (\$950); 4 months (\$1,480); 5 months (\$2,010)):					950.00
If Notice of Appeal is enclosed, add (\$330.00)					330.00
If Statutory Disclaimer under Rule 20(d) is enclosed, add fee (\$110.00)					
Information Disclosure Statement (Rule 1.17(p)) (\$180.00)					
Total of above Calculations =					\$ 1280.00
Reduction by 50% for filing by small entity (37 CFR 1.9, 1.27 & 1.28)					
TOTAL FEES DUE =					\$ 1280.00
(1) If entry (1) is less than entry (2), entry (3) is "0". (2) If entry (2) is less than 20, change entry (2) to "20". (4) If entry (4) is less than entry (5), entry (6) is "0". (5) If entry (5) is less than 3, change entry (5) to "3".					
METHOD OF PAYMENT					
<input checked="" type="checkbox"/> Check enclosed as payment.					
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<input type="checkbox"/> No payment is enclosed and no charges to the Deposit Account are authorized at this time (unless specifically required to obtain a filing date).					
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<input checked="" type="checkbox"/> The Commissioner is also authorized to credit any overpayments or charge any additional fees required under 37 CFR 1.16 (filing fees) or 37 CFR 1.17 (processing fees) during the prosecution of this application, including any related application(s) claiming benefit hereof pursuant to 35 USC § 120 (e.g., continuations/divisionals/CIPs under 37 CFR 1.53(b) and/or continuations/divisionals/CPAs under 37 CFR 1.53(d)) to maintain pendency hereof or of any such related application.					
SUBMITTED BY: STAAS & HALSEY LLP					
Typed Name		Richard A. Gollhofer		Reg. No.	31,106
Signature		<i>Richard A. Gollhofer</i>		Date	<i>6/8/04</i>

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